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SUPREME COURT OF THE UNITED STATES

NO. 4 7 1

PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1960

NO.

PREFORMED LINE PRODUCTS COMPANY

Petitioner

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS,

Respondent

PETITION FOR CERTIORARI

To The Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Petitioner, Preformed Line Products Company, respectfully prays that a writ of certiorari issue to the United States Court of Appeals for the District of Columbia Circuit to review the judgment of said court entered in the above-entitled cause on June 9, 1960, and docketed in that court as Appeal No. 15,270.

Opinion Below

The opinion of the United States Circuit Court of Appeals for the District of Columbia Circuit is reported at 280 F.2d 643, and is reproduced as an appendix to this petition. (pp. A-1 to A-4).

JURISDICTION

Judgment was entered by the U. S. District Court for the District of Columbia (C.A. No. 3229-54) dismissing the complaint on March 13, 1957. The U. S. Court of Appeals for the District of Columbia Circuit (Appeal No. 13938, decided June 26, 1958, 257 F.2d 664) entered judgment approving the judgment below, while provisionally vacating the latter to permit appellant to apply to the District Court for a new trial (Sup. J.A. 1-3). Petititon for rehearing denied September 4, 1958, without opinion. Certiorari denied January 26, 1959, (October term 1958, Petition No. 554, 358 U.S. 945).* Motion for new trial denied April 15, 1959. Appeal (No. 15,270) to the U. S. Court of Appeals for the District of Columbia Circuit was decided June 9, 1960, affirming the action taken below (280 F.2d 643).

Jurisdiction to review this case is based on Section 1254 (1) of the Judicial Code, as revised by the Act of June 25, 1948, [28 U.S.C. §1254 (1)].

QUESTIONS PRESENTED

1. Is the doctrine of separation of powers of government guaranteed by Articles I, II, and III, of the federal Constitution violated where a federal district court presumes to adjudge, *sua sponte*, certain claims unpatentable that had been patented by the Commissioner of Patents and concerning which no justiciable issue had been presented?

2. In *ex parte* actions under the Statute, 35 USC §145, against the Commissioner of Patents to authorize the issu-

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* The Solicitor General opposed issuing the writ partly on the merits and party because the judgment of the appellate court was not a final judgment, observing that petitioner would again have opportunity to apply for a writ of certiorari after final judgment. (Respondent's Brief, p. 9).

ance of a patent, does the District Court have jurisdiction voluntarily to entertain the question of patentability *vel non* of claims adjudged patentable in the Patent Office record?

3. Is not the *sua sponte* judgment by the Court, which purports to determine the question of the patentability *vel non* of claims already patented by the Commissioner of Patents, an unlawful usurpation of the administrative function by the judiciary, and a refusal to appellant of due process of the law?

4. Does not the language of the Statute, Title 35 USC §145, intend that the jurisdiction of the Court shall attach only as to the issues before the Board of Appeals of the Patent Office in *ex parte* cases?

5. In an interference proceeding, where the prevailing party before the Patent Office Board of Interference Examiners filed a statutory disclaimer of the claims at issue during pendency of an appeal from that judgment to the Court of Customs and Patent Appeals, what effect does such disclaimer have upon the judgment appealed from?

6. Upon motion duly brought, was it not within the original jurisdiction of the Commissioner of Patents to vacate the judgment of the Interference Board after the disclaimer and a concession of priority were filed? If so, did not the Patent Office Rules 262(a) and (d), and 263, make it mandatory upon him to do so?

7. In subsequent *ex parte* proceedings, where the Examiner applies the interference judgment adversely to appellant's right to certain claims, is not such action by the Examiner reviewable by the Patent Office Board of Appeals under 35 USC §7 and §134?

Statute Involved

Title 35 United States Code §145 (1952):

An applicant dissatisfied with the decision of the Board of Appeals, may, unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the appellant.

Statement of the Case

The facts material to the questions presented are:

Thomas F. Peterson, assignor to petitioner, Preformed Line Products Company (hereinafter referred to as "petitioner"), is the inventor and applicant of two applications for patent pertaining to preformed helices for the reinforcement, splicing, armoring, and dead ending of electrical transmission lines and other wires and cables: the first, Serial No. 698,312, being filed in the United States Patent Office on September 20, 1946 (Pl. Ex. 1A-1B, Joint App. 170); and the second, Serial No. 2,200, as a partial continuation of the subject matter of the first, being filed January 14, 1948 (Pl. Ex. 2A-2B, Joint App. 348).

The claims of the first application were rejected *inter alia* on a United States patent to one Bodendieck, No. 2,414,136, issued January 14, 1947, on an application filed May 9,

1945 (Joint App. 508). Because of alleged identity of subject matter, certain claims appearing in the Bodendieck patent were copied into petitioner's first application for purposes of interference.[1] Petitioner was denied the Bodendieck claims by the Primary Examiner on the grounds that the disclosure of the first application did not support them. Petitioner appealed this ruling to the Patent Office Board of Appeals.[2] Pending decision by that body, petitioner filed the second application, with modified disclosure, and incorporated the identical Bodendieck patented claims therein as a matter of original record. An interference (Pl. Ex. 3, Joint App. 432) was declared between petitioner's second application and the Bodendieck patent as to those claims.

As to the first application, the Board of Appeals decided (Joint App. 232) that its disclosure did support the patented claims, and so reversed the Primary Examiner. Thereupon, petitioner moved to add the first application to the interference in support of its right to the issues thereof. The Primary Examiner dissolved the interference (Joint App. 445, 452) on the grounds that neither petitioner's first nor second application supported the claims at issue, but was ultimately persuaded to reinstate the interference, and to transmit it for final determination to the Board of Interference Examiners (Joint App. 457-459). Evidence was adduced by the parties to establish whether Peterson or Bodendieck was the prior inventor. But the Interference Board, while implying that Peterson was probably the first inventor,[3] turned its decision (Joint App. 467-479) on the Primary Examiner's earlier decision, holding lack of basis in both of petitioner's applications to sup-

1. 35 U.S.C. § 135. Reproduced in the appendix to this petition, p. A-15, A-16.

2. 35 U.S.C. § 7 and § 134. Reproduced in the appendix hereto, p. A-15.

3. Joint App. 476, lines 16 *et seq.*, 478 lines 15-20.

port the contested claims, and so awarded priority to Bodendieck on this ground.[4]

Petitioner appealed from this *inter partes* judgment to the United States Court of Customs and Patent Appeals,[5] during the pendency of which appeal, but before the formal petition to that Court, or the transcript of the record had been lodged therein, Bodendieck filed his statutory disclaimer[6] (Joint App. 489) of the contested claims, and also filed a concession of priority of invention (Joint App. 490) as to the subject matter of such claims in favor of Peterson. Peterson seasonably moved the Commissioner of Patents to vacate the Interference Board's judgment,[7] and to dismiss the appeal to the Court of Customs and Patent Appeals. The motion was denied (Joint App. 492) on alleged lack of jurisdiction in the Commissioner to entertain it. Upon notice by the patentee, Bodendieck, that the interference was terminated,[8] the Commissioner so ruled, and remanded the case to the Primary Examiner in the Patent Office for further action *ex parte* (Joint App. 503).

The Primary Examiner then finally rejected the patented claims derived from Bodendieck in both of petitioner's applications on the grounds that the Interference Board's judgment was in effect *res judicata* as to petitioner's right thereto.

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4. Patent Office Rule 258, reproduced in the adjoined appendix, p. A-19.

5. 35 U.S.C. § 141 and § 142, reproduced in the adjoined appendix, pp. A-16, A-17.

6. Then Sec. 4917 R.S., 35 U.S.C. § 65; now 35 U.S.C. § 253, appendix hereto, p. A-18.

7. Patent Office Rules 262 and 263, reproduced in the appendix hereto, pp. A-19, A-20, were invoked based on the original jurisdiction of the Commissioner. Note the District Court's order reproduced in the adjoined appendix, p. A-5, and Conclusion of Law 15 appearing at p. A-14.

8. Court of Customs and Patent Appeals, Rule XXV, reproduced herein, p. A-20.

On a second appeal *ex parte* to the Board of Appeals taken by petitioner from such final rejections, that body affirmed the Primary Examiner (Joint App.—1st appl'n 298; 2nd appl'n 420), and upon petition for reconsideration, held (Ibid. 340; 430) that it was without authority to review a decision of the Interference Board, or a ruling by the Commissioner of Patents, even under the guise of a final rejection by the Primary Examiner. Petition to the Commissioner invoking the supervisory authority of that office to direct the Board of Appeals to review this final rejection of the Primary Examiner as required by Statute was denied (Joint App. 348).

From this action petitioner proceeded by a bill in equity against the Commissioner of Patents to the United States District Court for the District of Columbia under the provisions of the Statute, 35 USC § 145. The District Court ruled that the Interference Board's judgment was a final judgment; and further held, *sua sponte*, that there was no patentable novelty in any of the claims before the Court, including the previously patented claims that constituted the issues of the *Peterson* v. *Bodendieck* Interference, and for these and other reasons dismissed the complaint.[10]

On appeal, the Circuit Court of Appeals, after briefs, oral hearing, and additional memoranda filed at the request of the Court, ruled that "We do not question the propriety of the District Court's action in raising, *sua sponte*, the issue of patentability *vel non*", inviting comparison with *Hill* v. *Wooster*, 132 U. S. 693, 698 (1890); *Knutson* v. *Galls-*

9. 35 U.S.C. § 7; 35 U.S.C. § 134, *supra*.

10. The decision of the District Court was rendered orally from the bench at the conclusion of the trial. It is reproduced in the Joint Appendix at pages 44-53; Judgment and Order settling findings of fact and conclusions of law, 24-26; the Findings of Fact and Conclusions of Law are set forth in the Appendix to this petition, pp. A-5 to A-14.

worthy, 82 U. S. App. D. C. 304, 306-308; 164 F. (2d) 497, 499-501 (1947); *Radtke Patents Corp.* v. *Coe*, 74 App. D. C. 251, 122 F. (2d) 937 (1941), but deemed that fairness required a trial of that issue before rendition of judgment.[11] Accordingly, the Appellate Court conditionally vacated the District Court's order, and gave petitioner sixty (60) days in which to apply to the District Court for a new trial without prejudice to further appellate action in the case, either as to the disposition of such application, or as to the outcome of the new trial if granted and prosecuted.

Should petitioner fail to proceed with the application for new trial within the time allotted, the Appellate Court ordered that the District Court's judgment would in that event be reinstated. No disposition of the jurisdictional question or any of the other issues on appeal were made, and petition for rehearing was denied without opinion.

Petitioner then moved the District Court for a new trial, offering the Bodendieck patent file history in which the interfering claims had been originally patented as evidence of their patentability. The application was denied, whereupon the second appeal to the Circuit Court of Appeals was taken which affirmed the action of the court below both in its initial judgment and in its denial of the motion for new trial without passing on the jurisdictional questions raised. (Decision reproduced herein in attached appendix, pp. A-1 to A-4.) From this decision, the present petition is brought.

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11. Decision reproduced in the Supplemental Joint Appendix A-1. See note 2 in the margin, p. A-3.

ARGUMENT FOR ALLOWING THE WRIT

There is No Constitutional Warrant for the Court's Assumption of Jurisdiction to Set Aside an Administrative Function Properly Exercised.

It is an established fundamental principle of constitutional law that one department of government cannot interfere with, or encroach upon, any of the other departments. The entertainment of the question of patentability *vel non* of claims, not in issue, that were patented by the Commissioner of Patents, and the *sua sponte* ruling against the patentability of such claims, are such an encroachment that cannot be justified by the reasoning applied in *United States* v. *Duell*, 172 U.S. 576, at 586-89. Thus, is the jurisdiction of the District Court to entertain the issue of patentability *vel non* under these facts brought into question.

There is no authority for the Court to enter a judgment on which there is no justiciable issue; to approve the *sua sponte* judgment of the Court against the patentability of claims not in issue is to deprive petitioner of due process.

The case of *United States* v. *Duell*, *supra*, decided that because the Commissioner's function is quasi-judicial, it is constitutional to grant a right of appeal from his ruling to the courts without conferring executive power upon the latter. In the *Duell* case, the record submitted for the determination of the Court embraced the issues before the Patent Office, and none other. The Court was discharging its statutory responsibility in passing on such issues, without trespassing upon the executive power of the Commissioner.

The facts at bar do not coincide with those of the *Duell* case. Certain claims had been adjudged patentable by the Commissioner of Patents, and had actually been patented to one Bodendieck, No. 2,414,136 (Joint App. 508-19). These claims were adopted in petitioner's first application,

and were adjudged to be supported by the disclosure thereof by the Board of Appeals over the objection of the Examiner (Joint App. 232-36).

The same claims were also asserted in the second application as a matter of original record (Claims 17, 18; Joint App. 360-61), pending the *ex parte* decision of the Board respecting applicant's right to make them in his first application. In the ensuing interference between the patentee Bodendieck and the second application, after the decision of the Board favorable to applicant's right to assert the issues in his first application, the applicant-interferant moved to add the latter to the interference, but was ultimately adjudged not to be entitled thereto in either application for lack of disclosure.[12]

The issues presented to the District Court as to these claims concerned only the point of whether or not applicant was entitled to assert them in his first application under the warrant of his disclosure, and as to the effect of the disclaimer filed by the patentee Bodendieck on the interference judgment adverse to appellant. There was no justiciable issue before the District Court regarding the patentability *vel non* of these claims.

The Supreme Court in *Butterworth* v. *Hoe*, 112 U.S. 50, as was reaffirmed in the *Duell* case, *supra*, held that it was the legislative intent of Congress to empower the Commissioner of Patents to grant or withhold patents to applicants therefor subject to judicial review prescribed by statute in case of decisions *adverse* to the applicant.

In trials *de novo* under the old Section 4915 R.S., now 35 U.S.C. §145, the justiciable issues in *ex parte* cases

12. A remarkable conclusion in light of the claims being of original record in the second case and tributary to its disclosure thereby. *Mark* v. *Hodgins*, 99 USPQ 23, 25; *Ex Parte Joshua*, 48 USPQ 650.

were necessarily those which arose from an applicant's assertion and the Commissioner's refusal of certain claims. Obviously, as to claims already awarded an applicant, there could be no issue in *ex parte* proceedings. The Commissioner, having exercised his discretion and determined the patentability of such claims, had satisfied the applicant's right thereto, thus foreclosing the need and the possibility of judicial process as to them.

The federal constitution creates three distinct and separate departments—legislative, executive, and judicial. *O'Donohue* v. *U. S.*, 53 S. Ct. 740; 289 U. S. 516.

It is an established and fundamental principle of constitutional law that one department cannot interfere with, or encroach on, either of the other departments.

Humphrey's Ex'r v. *U. S.*, 55 S. Ct. 869; 295 U. S. 602.

Springer v. *Gov't Philippine Is.*, 48 S. Ct. 480; 277 U. S. 189.

Massachusetts v. *Mellon*, 43 S. Ct. 597; 262 U. S. 447.

O'Malley v. *U. S.* appeal dismissed; *Pendergast* v. *U. S.*, 62 S. Ct. 116; 314 U. S. 574, and 63 S. Ct. 268, 317 U. S. 412 (reversing on other grounds).

No deviation from the constitutional requirement will be tolerated which impairs the essential integrity of one of the branches of the government. *Watkins* v. *U. S.*, 77 S. Ct. 1173; 354 U. S. 178.

As a general rule, in the absence of constitutional authorization, the judicial branch of the government cannot exercise powers and functions of the executive branch.

Slocum v. *Rwy. Co.*, 70 S. Ct. 577; 339 U. S. 239.

Aircraft & Diesel Equip. Co. v. *Hirsch*, 67 S. Ct. 1493; 331 U. S. 752.

Confederated Ute Indians v. *U. S.*, 67 S. Ct. 650; 330 U. S. 169.

Perkins v. *Lukens Steel*, 60 S. Ct. 869; 310 U. S. 113.

It is the duty of a Court to give effect to the proved official acts of the officers of the government in matters in which they have jurisdiction.

Cummings v. *Isenberg*, 67 App. D. C. 17; 89 F. 2d 489; Cert. den. 57 S. Ct. 783; 301 U. S. 682; Rehearing den. 57 S. Ct. 921; 301 U. S. 713.

The judicial branch may interfere with administrative activities of the executive branch only where a statute has imposed a specific duty on the courts with respect to them.

Cudahy Packing Co. v. *Fleming*, 122 F. 2d 1005, reversed on other grounds.

Cudahy Packing v. *Holland*, 62 S. Ct. 803; 315 U. S. 785—and not otherwise.

Bailey v. *Richardson*, 86 U. S. App. D. C. 248; 182 F. 2d 46; affirmed 71 S. Ct. 669; 341 U. S. 918.

Int'l Workers v. *McGrath*, 86 U. S. App. D. C. 287; 182 F. 2d 368; affirmed 71 S. Ct. 624; 341 U. S. 123.

Judicial power extends only to correction of an officer's failure to proceed according to and within the law, where constitutionality of the law authorizing the officer to act has been determined.

Kleberg & Co. v. *U. S. Custom & Pat. Appeals*, 71 F. 2d 332.

In the absence of clear evidence of a failure to exercise a legal discretion, a Court may not substitute its discretion or notion of expediency and fairness for that of executive or administrative officers, boards, and commissions, —

Aircraft & Diesel Equip. Co. v. *Hirsch*, *supra*.

SEC v. *Chenery Corp.*, 63 S. Ct. 454; 318 U. S. 80.

Texas R. R. Commission v. *Rowan & Nicholson Oil Co.*, 60 S. Ct. 1021; 310 U. S. 573; Rehearing den. 61 S. Ct. 66; 311 U. S. 614, and 61 S. Ct. 167; 311 U. S. 727.

U. S. v. *Geo. S. Bush Co.* (CCPA), 60 S. Ct. 944; 310 U. S. 371.

A. T. & T. v. *U. S.*, 57 S. Ct. 170; 299 U. S. 232.

Dismuke v. *U. S.* 56 S. Ct. 400; 297 U. S. 167; Rehearing denied 56 S. Ct. 594; 297 U. S. 728.

or interfere with or control such officers or bodies in the exercise of any power or the performance of any duty of an executive or administrative character, in which the constitution contemplates the exercise of discretion.

Aircraft & Diesel Equip. v. *Hirsch*, *supra*.

Am. Power & Light v. *SEC*, 67 S. Ct. 133; 329 U. S. 90.

Texas R. R. Com. v. *Rowan et al.*, *supra*.

Perkins v. *Lukens Steel*, *supra*.

Dow v. *Ickes*, 74 App. D. C. 319; 123 F. 2d 909, followed in

Gilbert v. *Ickes*, 74 App. D. C. 327; 123 F. 2d 917; Cert. den. 62 S. Ct. 639; 315 U. S. 807; Rehearing den. 912; U. S. 830.

Chief Justice Taney, speaking for the Supreme Court in the case of *Decatur* v. *Paulding*, 14 Peters 497, 515 said:

> "If a suit should come before this court, which involved the construction of any of these laws, the court certainly would not be bound to adopt the construction given by the head of a department. And if they supposed his decision to be wrong, they would, of course, so pronounce their judgment. But their judgment upon the construction of a law must be given in a case in which they have jurisdiction, and in which it is their duty to interpret the act of congress, in order to ascertain the rights of the parties in the cause before them. The court could not entertain an appeal from the decision of one of the secretaries, nor revise his judgment in any case where the law authorized him to exercise discretion or judgment. Nor can it, by *mandamus*, act directly upon the officer, and guide and control his judgment or discretion in the matters committed to his care, in the ordinary discharge of his official duties.
>
> * * *
>
> "The interference of the courts with the performance of the ordinary duties of the executive departments of the government, would be productive of nothing but mischief; and we are quite satisfied, that such a power was never intended to be given to them."

This case was cited and followed by the Supreme Court in the case of the *Commissioner of Patents* v. *Whiteley*, 4 Wallace (71 U. S.) 522, 534, which, in turn, is cited in *Butterworth* v. *Hoe*, at page 68.

The Supreme Court in *Massachusetts* v. *Mellon*, 262 U. S. 447, 488, had this to say respecting a separation of powers of government:

> "The functions of government under our system are apportioned. To the legislative department has been committed the duty of making laws; to the executive the duty of executing them; and to the judiciary the

duty of interpreting and applying them in cases properly brought before the courts. The general rule is that neither department may invade the province of the other and neither may control, direct or restrain the action of the other. We are not now speaking of the merely ministerial duties of officials. *Gaines* v. *Thompson*, 7 Wall. 347. We have no power *per se* to review and annul acts of Congress on the ground that they are unconstitutional. That question may be considered only when the justification for some direct injury suffered or threatened, *presenting a justiciable issue*, is made to rest upon such an act. Then the power exercised is that of ascertaining and declaring the law applicable to the controversy. It amounts to little more than the negative power to disregard an unconstitutional enactment, which otherwise would stand in the way of the enforcement of a legal right. The party who invokes the power must be able to show not only that the statute is invalid but that he has sustained or is immediately in danger of sustaining some direct injury as the result of its enforcement, *and not merely that he suffers in some indefinite way in common with people generally.* If a case for preventive relief be presented the Court enjoins, in effect, not the execution of the statute, but the acts of the official, the statute notwithstanding. Here the parties plaintiff have no such case. Looking through forms of words to the substance of their complaint, it is merely that officials of the executive department of the government are executing and will execute an act of Congress asserted to be unconstitutional; and this we are asked to prevent. *To do so would be not to decide a judicial controversy, but to assume a position of authority over the governmental acts of another and co-equal department, an authority which plainly we do not possess.*" (Emphasis added)

In *Security Exchange Commission* v. *Chenery Corp.*, 318 U. S. 80, 87, Mr. Justice Frankfurter rendered the opinion of the Supreme Court, as follows:

"• • • The grounds upon which an administrative order must be judged are those upon which the record discloses that its action was based.

• • • • • •

"• • • But it is also familiar appellate procedure that where correctness of the lower court's decision depends upon a determination of fact which only a jury could make but which has not been made, the appellate court cannot take the place of the jury. Like considerations govern review of administrative orders. If an order is valid only as a determination of policy or judgment which the agency alone is authorized to make and which it has not made, a judicial judgment cannot be made to do service for an administrative judgment. For purposes of affirming no less than reversing its orders, an appellate court cannot intrude upon the domain which Congress has exclusively entrusted to an administrative agency." (88)

• • • • • •

"• • • For the Courts cannot exercise their duty of review unless they are advised of the considerations underlying the action under review. If the action rests upon an administrative determination—an exercise of judgment in an area which Congress has entrusted to the agency—of course it must not be set aside because the reviewing Court might have made a different determination were it empowered to do so." (94)

Another case in point from this same Appellate Court to the Supreme Court is *Aircraft & Diesel Corp.* v. *Hirsch*, 331 U. S. 752, 767:

"The very purpose of providing either an exclusive or an initial and preliminary administrative determination is to secure the administrative judgment either, in the one case, in substitution for judicial decision or, in the other, as foundation for or perchance to make unnecessary later judicial proceedings. Where Congress has clearly commanded that administrative judg-

ment be taken initially or exclusively, the courts have no lawful function to anticipate the administrative decision with their own, whether or not when it has been rendered they may intervene either in presumed accordance with Congress' will or because, for constitutional reasons, its will to exclude them has been exerted in an invalid manner. To do this not only would contravene the will of Congress as a matter of restricting or deferring judicial action., It would nullify the congressional objects in providing the administrative determination. In this case these include securing uniformity of administrative policy and disposition,[25] expertness of judgment, and finality in determination at least of those things which Congress intended to and could commit to such agencies for final decision." (The footnote 25 refers to 89 Cong. Rec. 9928-29.)

Perhaps ancillary to the foregoing, is the proposition that a claim patented by the Commissioner of Patents is *prima facie* valid. The presumption of validity is overturned only by clear and convincing evidence. As stated by the Court, "The requirement of proof to sustain the burden is heavy." *Haloro, Inc.* v. *Owens-Corning Fibreglas Corp.*, 121 U. S. P. Q. 339, 340; 266 F. 2d 918, 919. This was an infringement suit involving a patent which the Appellate Court had authorized under a precedental action brought under 4915 R. S. (now 35 U.S.C. §145).

In the present proceeding, however, the Appellate Court did not question the propriety of the District Court's action in raising *sua sponte* the issue of patentability *vel non* of patented claims (Sup. J. A. 3), even in face of no justiciable issue presented to the point, and no evidence addressed to it. Whatever else may be concluded from these disparate views, it is clear that there are two standards for testing the validity of patented claims: (1) Where the issue is *inter partes* and raised defensively, the onus of him who pleads against the validity is heavy; (2) where as here,

the proceedings are *ex parte*, the presumption in favor of validity is so inconsequential as to be voidable at the whim of a court. It is hardly credible that such a double-standard could lawfully coexist when both classes of claims are patented under the fiat of the Commissioner of Patents by the authority of the Congress invested in that office (Constitution, Art. I, Sec. 8).

The *sua sponte* judgment of the District Court should be disapproved and overruled accordingly.

Denial of This Petition Would be Tantamount to Relegating the Functions of the Patent Office to the District Court:

An *ex parte* applicant under 35 USC § 145 brings his bill in the District Court, not to test the propriety of the actions taken that are favorable to him in the Patent Office, but for relief from the adverse rulings with which he is "dissatisfied" by the Board of Appeals in the Patent Office after all administrative processes have otherwise been exhausted. The language of the statute seems to leave no doubt that this was the legislative intent of the Congress.

> "An applicant *dissatisfied with the decision of the Board of Appeals* may . . . have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia . . . The court may adjudge that such applicant is entitled to receive a patent for his invention, *as specified in any of his claims involved in the decision of the Board of Appeals*, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law." (Emphasis supplied)

It is not seen wherein a litigant under this section of the statute stands in any different capacity before the Court than do other litigants. It is trite law that the issues are

framed by the pleadings upon which they become joined. There was no issue joined on the pleadings in this case respecting the patentability *vel non* of the claims that comprised the issues of the *Peterson* v. *Bodendieck* Interference. They were before the Board of Appeals and before the Court below on the grounds of whether the judgment of the Interference Board is *res judicata* with respect to petitioner's right to them after being disclaimed under the statute[13] by the patentee Bodendieck ensuing such judgment.

The action of the trial Court in holding, *sua sponte*, that such claims were not patentable over the prior art,[14] over which they had been allowed in the Patent Office, was an action taken outside of the framework of the pleadings, and contrary to all the evidence and the posture of the parties before the Court. Therefore, a refusal by this Court to issue the writ sought by this petition would tacitly approve this extrajudicial course of action, and would be tantamount to relegating to the federal courts the administrative and quasi-judicial functions reserved by the Congress under the statutes to the Patent Office.[15]

Decision Below Not Consistent with Decisions of This Court

Butterworth v. Hoe, 112 U. S. 50 (1684):

In this case the Court analyzed the historic development of the Patent Statutes and concluded that the power of the Commissioner of Patents to issue a patent was absolute if he "shall deem it to be sufficiently useful and important"

13. Formerly Sec. 4917 R.S., 35 U.S.C. § 65; now 35 U.S.C. § 253. Reproduced in the appendix to this petition, p. A-12.
14. Joint App. 52; Findings of Fact 30, 31; reproduced herein, p. A-11.
15. *Butterworth* v. *Hoe*, 112 U.S. 50, 64, 68.

(p. 64), and that remedy by a bill in equity under §4915 (now 35 USC §145, §146)[16] is appropriate only when the Commissioner decides to reject an application for a patent on the ground that an applicant is not, on the merits, entitled to it (p. 68).

The office of the Commissioner of Patents, being by nature one which requires the discharge of a judicial function, has the first and final word in adjudging a claim patentable. If the Commissioner decides a claim is patentable on its merits, then his decision is not subject either to administrative or judicial review, the latter being invoked only in the case of *adverse* decisions on the merits by the Commissioner.

The present action by the District Court in declaring, *sua sponte*, unpatentable, claims that the Commissioner had adjudged patentable, is clearly opposed to the intentions of the statute as construed by this Court in *Butterworth* v. *Hoe*, *supra*.

Hill v. Wooster, 132 U. S. 693 (1889):

This case involved an interference contest between two parties, in which the patentability of the contested subject matter was passed upon by the appellate court for the first time. The losing party in the Patent Office brought his bill under §4915 R. S. in the Circuit Court. That court regarded only the question of priority of invention and entered its judgment accordingly.

On appeal to the Supreme Court, this body entered its opinion that nothing in the claims at issue constituted patentable invention.

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16. § 145, *supra*, pp. 3-4; § 146 is reproduced in the appendix hereto, p. A-17.

By the Court (p. 698):

> "It necessarily follows that no adjudication can be made in favor of the applicant, unless the alleged invention for which a patent is sought is a patentable invention."

The court observed that the litigation between the parties could not be concluded solely on the issue of priority when a determination of that issue would authorize the Commissioner to issue a patent to the prevailing party for the claims in interference, which would necessarily lend the court's sanction to the patentability of the invention involved.

> "But neither the Circuit Court nor this court can overlook the question of patentability."

It is a condition precedent to the declaration of an interference that the subject matter be adjudged patentable by the Commissioner (Patent Office Rule 201). There can be no interference unless the subject matter is patentable. Therefore, an *inter partes* contest, such as maintained in the *Hill* v. *Wooster* case, becomes a non-suit if the subject matter involved is not patentable. It is believed that this was the full of the intention of the court in its pronouncement in the *Hill* v. *Wooster* decision, and does not bear upon *ex parte* suits.

Hoover v. Coe, 325 U. S. 79 (1954):

This case was an *ex parte* action brought by an applicant for a patent under R. S. 4915 against the Commissioner of Patents. The question presented here was whether the District Court had jurisdiction under R. S. 4915 to review the refusal of a claim for patent as not reading on the disclosure of claimant's application. The trial court ruled with the Patent Office that the claim was not supported. On

appeal, the Circuit Court of Appeals for the District of Columbia Circuit raised the question, *sua sponte*, "whether (R. S. 4915) confers jurisdiction on the District Court to enter a decree which does not determine the right of the applicant to receive a patent, but which instead directs the Examiner to allow claims for the purpose of provoking subsequent interference proceedings." (p. 81)

The Appellate Court decided that the District Court lacked jurisdiction of the suit and affirmed the judgment, dismissing the complaint.

This Court, in a careful review of Sections 4915 and 4911 R. S., held that the District Court had jurisdiction over a suit taken from the refusal of the Board of Appeals of the Patent Office to issue a patent—whatever be the grounds for such refusal. By the Court (p. 83):

> "It is evident that alternative rights of review are accorded an applicant,—one by appeal to the United States Court of Customs and Patent Appeals, the other by bill in equity filed in one of the federal district courts. In the first the hearing is summary and solely on the record made in the Patent Office (with footnote reference to R. S. 4914, 35 U. S. C. §62); in the other a formal trial is afforded on proof which may include evidence not presented in the Patent Office (with footnote reference to *Butterworth* v. *Hoe*, 112 U. S. 50, 61). Every party adversely affected by a ruling on the merits may, if he so elect, proceed by bill rather than by appeal. In the one case the adjudication in equity authorizes issue of a patent on the applicant's 'otherwise complying with the requirements of law.' In the other the decision 'shall govern the further proceedings in the case' in the Patent Office (with footnote reference to R. S. 4911, *supra*)."

On the question as to whether the differences between the statutory provisions of R. S. 4915 and 4911 required

the holding that as to all decisions adverse to the applicant that are *not* final as to the issuance of a patent, his remedy had to be by review on appeal to the C. C. P. A., the Court pointed out that R. S. 4915 warranted no such construction, concluding (p. 84):

> "On the face of the statutes the applicant is given alternative remedies resulting in the same sort of relief so far as concerns the further prosecution of the application in the Patent Office."

This Court then proceeded to distinguish the *Hill* v. *Wooster* case, and the case of *Radtke Patents Corp.* v. *Coe*, 122 F. 2d 937, on both of which the Court below relied, pointing to the *inter partes* nature of both of these proceedings and its own ruling (in the *Hill* case) to the effect that in a suit by an unsuccessful applicant against a successful one, "* * * if it appeared that neither application disclosed invention (a matter which should have moved the Commissioner not to declare an interference) the bill should be dismissed. The Court did not purport to decide what Patent Office rulings are reviewable under R. S. 4915." (p. 90) The Court thus reversed and remanded for further proceedings in conformity with its opinion.

The Court, in this same decision, as noted above, compared the procedures available to applicants from adverse decisions in the Patent Office in both *ex parte* and *inter partes* causes, including the right to summary review to the Court of Customs and Patent Appeals, or the right to proceed by a bill in equity in the Federal District Court, these being mutually exclusive courses of action. There seems to be little doubt that this Court regards these courses of action as equal alternative ways of review in *ex parte* cases as affects an applicant's rights before the Patent Office according to the decision in *Hoover* v. *Coe*, *supra*. It is also apparent that this judgment of claims as

unpatentable (that had been held by the Patent Office to be patentable) could not happen in a summary review by the Court of Customs and Patent Appeals for obvious lack of jurisdiction over such claims. Therefore, according to the rationale of *Hoover* v. *Coe*, it should not happen in a trial in equity for the same reasons.[17]

Conclusions

From the foregoing decisions, a difference appears to arise between *inter partes* actions, as in the *Hill* v. *Wooster* case, and *ex parte* actions, such as *Hoover* v. *Coe*. The Court of Appeals for the Third Circuit in *Starlock Mfg. Co.* v. *Kublanow*, 106 F. (2d) 495, 500, regarded it necessary for the court, as guardian of the public interest in *inter partes* cases, to determine the patentability (validity) of the claims involved, though not in issue in the case.

Justice Stevens in his dissent (pp. 955, 956) in *Radtke Patents Corp.* v. *Coe*, 122 F. (2d) 937, suggests that the court is guardian of the public interest only in cases where the Commissioner of Patents is not before the court as a party to act in that capacity. This view of the law seems consonant with the authority of the Commissioner under the Patent Statutes as discussed in *Butterworth* v. *Hoe*, *supra*, and is not inconsistent with the decisions of this Court in *Hill* v. *Wooster* and in *Hoover* v. *Coe*, *supra*.

Although at one time *inter partes* and *ex partes* actions were both enabled under the provisions of §4915 R. S., they are now separately provided for in §145 and §146, respectively, Title 35 U. S. C. As such, the *stare decisis* of the one need not be applicable to the other, as is indicated by the

17. For a discussion of the extent of appellate jurisdiction over claims adjudged patentable in the Patent Office, attention is invited to the decision in *Watson, Commissioner of Patents* v. *Bruns*, 99 U. S. App. D. C. 327; 239 F. (2d) 948.

Hoover v. *Coe* and the *Hill* v. *Wooster* decisions by this Court, mentioned above. These decisions, coupled with that of *Butterworth* v. *Hoe*, are persuasive to the conclusion that where the Commissioner of Patents is present as a party to the action, his decision as to the patentability of the claims on their merits cannot properly be raised under the statute. Petitioner is before the Court in just such an *ex parte* status under the provisions of 35 U. S. C. §145.

The Statute does not affirmatively empower the District Court to attack such claims as being unpatentable. There is nothing in the *ex parte* cases decided by this Court which would sanction the action of the Court of Appeals below in approving such *sua sponte* ruling by the District Court, nor in implying jurisdiction in the latter to try the patentability, *vel non*, of such claims by allowing petitioner to apply for a new trial to test that issue.

Second Jurisdictional Question

The filing of the statutory disclaimer and concession of priority of the counts at issue by the patentee after judgment of the Board of Interference Examiners awarding priority to him, and during the pendency of an appeal to the Court of Customs and Patent Appeals from said judgment, poses several jurisdictional issues concerning which there are no direct precedents, leading to the conclusion that the case at bar is one of first impression.

As was done in this case, the timely filing of a notice of intention to appeal to the Court of Customs and Patent Appeals with the Commissioner of Patents, accompanied by a statement of the reasons for appeal, as provided in Title 35 U. S. C. § 142, confers appellate jurisdiction upon that Court, as construed by it in its decision in *Galena Mfg. Co.* v. *Superior Oil Works*, 26 CCPA, 1301; 104 Fed. (2d) 400. The appeal from the interference

judgment was, therefore, pending; the judgment of the Interference Board had not become final, and the interference proceeding was still in progress. Under this situation, the patentee Bodendieck filed his statutory disclaimer of the counts at issue of the interference and conceded priority of the subject matter thereof to Peterson.

Rule 262(a) (Pet. App. A-19, A-20, *infra*) provides:

> "An applicant or a patentee involved in an interference may, *at any time*, file a written disclaimer or concession of priority * * *. Upon the filing of such an instrument by any party, judgment shall be rendered against him." (Emphasis added.)

Rule 262(d) provides:

> "Such disclaimer, concession of priority, * * * shall operate without further action as a direction to cancel the claims involved from the application of the party making the same on termination of the interference on the basis thereof."

Rule 263 distinguishes statutory disclaimers from those made under Rule 262 for purposes of voiding the contest. This rule provides for the statutory disclaimer by a patentee and states:

> "The disclaimer referred to in rule 262, when made by a patentee in interference is not a disclaimer under 35 U. S. C. 253. If a disclaimer under the statute (see rule 321) cancelling claims involved in the interference from the patent, is made by the patentee, * * * the interference will be dissolved *pro forma* as to such claims."

In the present case, petitioner's opponent was a patentee and did file a statutory disclaimer, but since this also was accompanied by a concession of priority, reference is made to the above quoted portions of Rule 262, as well as to Rule 263. Since the Patent Office Rules, to the extent that

they are consistent with the law, have the effect of law, Rules 262 and 263 are binding upon the Commissioner to vacate the judgment of the Interference Board; to dismiss the appeal, and to dissolve the interference without prejudice to petitioner's right to assert the claims formerly at issue in the interference. This, however, he refused to do.

Third Jurisdictional Question

The Patent Office contends, and the courts below agree, that the interference terminated not upon the filing of the disclaimer, but thereafter, when petitioner's time for perfecting his appeal expired without his having done so. On this basis, it is contended by the Patent Office and the courts below that the judgment of the Interference Board became final and the issues raised thereby became *res judicata* in so far as subsequent proceedings before the Patent Office were concerned.

The Examiner, in the resumption of the *ex parte* prosecution of petitioner's applications, entered such rejection of *res judicata*, which was taken to the Board of Appeals of the Patent Office as one of the grounds of appeal reviewable under its statutory authority. The Board of Appeals refused to review this rejection on its merits on the basis that it was without jurisdiction to do so; because of the judgment of the Interference Board, and because of the actions taken by the Commissioner in refusing to vacate such judgment. This poses the third jurisdictional question which petitioner believes to be founded in error.

The statutory authority of the Board of Appeals of the Patent Office lies in 35 USC 7, and an applicant's right to a review by the Board of Appeals is set forth in 35 USC 134. No exception is made in these statutory provisions for the Board's refusal to review the rejection of the Examiner as has been entered against petitioner in the cases

at bar. The judgment of the Interference Board awarding priority to Bodendieck was a judgment predicated *not* upon the issues of priority, nor upon the sufficiency of the proofs adduced to support it, but rather turned upon the fact that petitioner's application did not disclose sufficient basis to support the interference claims, and particularly the earlier application.

Therefore, after the resumption of *ex parte* prosecution of those applications, the controlling precedent, amounting to the *law of the case* that remained in effect, was that of the decision of the Board of Appeals in the first *ex parte* Appeal No. 15,663, in which it was held that applicant (petitioner) had the right to make and maintain the interfering claims in his first application.

Thus, after the filing of the disclaimer, these claims should have been reallowed to applicant (petitioner) on the basis that his right to make them (i.e., sufficiency of disclosure) is *res judicata* to the Examiner, to the Board of Appeals, and higher authority, up to and including this Court. In this manner is the jurisdictional issue posed.

The Writ should issue.

Respectfully submitted,

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~~December 1, 1958~~
October 7, 1960

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 15270

PREFORMED LINE PRODUCTS COMPANY, APPELLANT

v.

ROBERT C. WATSON, Commissioner of Patents, APPELLEE

Appeal from the United States District Court
for the District of Columbia

Decided June 9, 1960

Mr. Patrick H. Hume, with whom *Messrs. C. Willard Hayes and George M. Sirilla* were on the brief, for appellant.

Mr. *George C. Roeming*, Attorney, United States Patent Office, with whom *Mr. Clarence W. Moore*, Solicitor, United States Patent Office, was on the brief, for appellee.

Before PRETTYMAN, *Chief Judge*, and BAZELON and FAHY, *Circuit Judges*.

FAHY, *Circuit Judge*: This is an appeal from an order of the District Court denying appellant's motion for a new trial after our demand of the case on a previous appeal. *Preformed Line Prods. Co.* v. *Watson*, 103 U.S. App. D.C. 286, 257 F.2d 664, *cert. denied*, 358 U.S. 945. We then vacated conditionally the judgment of the District Court of March 13, 1957, dismissing appellant's complaint

under 35 U.S.C. §145 (1958), which had sought issuance of a patent.

In the former case, the District Court had rejected appellant's claims on two alternative grounds: first, it agreed with the Patent Office in holding that certain of appellant's claims were barred because of res judicata growing out of various proceedings in the Patent Office,[1] and that the other claims were barred because of lack of novelty; second, it held that all the claims before the court on the merits lacked the requisite novelty over the teaching of the prior art. Since, however, the second or alternative holding of nonpatentability was not framed as an issue before the court at the outset of the proceeding, on demand of the case we ordered that the District Court's judgment be conditionally vacated "in the interest of justice," with permission given to appellant to apply within sixty days for a new trial "based on a proffer of evidence on the issue of patentability." After unsuccessful petitions for rehearing in this court and certiorari in the Supreme Court appellant moved within the proper time for a new trial in the District Court and that motion was denied.

Involved are applications[2] for a patent entitled "Helically-Preformed Wire Envelope and Methods of Use." The applications disclose preformed helical (spiral) elements and certain kinds of tube-like metal structures which are produced from these helical elements. In various combinations and lengths depending on their purpose

[1] Specifically the holding was that in the absence of a perfected appeal to the Court of Customs and Patent Appeals, the nonvacated decision of the Board of Interference Examiners adverse to appellant was a final judgment as to claims involved in the interference proceedings and therefore res judicata.

[2] Two applications are involved. Serial No. 698,312 and Serial No. 2,260. The latter is a continuation-in-part of the former.

these preformed helices are used for the reinforcement, splicing, armoring and dead-ending of electrical transmission lines and other wires and cables.

The prior art upon which the District Court primarily relied in rejecting all of appellant's claims on the merits was a patent issued to one Moxham in 1886. That patent discloses the same basic helically preformed element as found in appellant's applications and a plurality of these preformed elements indefinite in length which could be useful as a traction cable for cable railways. In another form of the Moxham patent helically preformed elements of the same diameter and pitch could be assembled to form a hollow flexible tube.

Upon re-examination of the issue of the propriety of the District Court's action in raising and deciding the issue of patentability *vel non*, we conclude as we did in the prior appeal that such action was authorized in law. *Preformed Line Prods. Co.* v. *Watson*, 103 U.S. App. D.C. at 288, 257 F.2d at 666 (footnote 2 and cases therein cited).

We think, moreover, that the findings of the District Court on the issue of patentability, both as to those claims in which it agreed with the Patent Office and also those where it ruled *sua sponte*, were justified. Differences appellant claims between the disclosures of the two patents are differences only of degree and use which would be obvious from Moxham to one having ordinary skill in the art. For instance, the claims upon which the District Court made *sua sponte* findings of unpatentability over Moxham were so-called "method claims." But these methods, mainly concerning the assembling of the preformed helical elements either to form a hollow tube or a tube over a core, suggest no significant advance

from what would be obvious to one skilled in the art upon the disclosure of Moxham.

Finally, the proffer of evidence submitted by appellant in his motion for new trial and affidavit in support thereof, did not in the circumstances require the court to grant a new trial. Aside from his proffer of the prosecutional history of the Bodendieck patent[1] in the Patent Office, appellant offered only "expert testimony," unspecified as to source or content, to support his claim of patentability over Moxham. The possible relevance of the Bodendieck history was not shown and the proffer of expert testimony was in terms too general to require the grant of a new trial.

Since we find no error in the holding of the District Court on the issue of patentability over the prior art, and since all of appellant's claims on the merits were rejected by the District Court on the basis of the prior art, we need not rule on other questions raised.

The order of the District Court denying appellant's motion for a new trial is affirmed, and the judgment entered by the District Court in this cause on March 13, 1957, is reinstated.

It is so ordered.

[1] With reference to certain of appellant's claims an interference was declared in the Patent Office between appellant's applications and that of one Bodendieck.

FINDINGS OF FACT AND CONCLUSIONS OF LAW

The following are the Findings of Fact and Conclusions of Law adopted by the trial Court (Order, Joint App. 25, 26) as set forth in the Joint Appendix at pages 26 to 35, and 38 to 40, all inclusive, except that plaintiff's proposed Conclusions of Law, P-1, P-5, P-7, P-10, and P-11, allowed by the Court, have been renumbered in the Conclusions of Law set forth below as Nos. 14 to 18 inclusive, so as to follow consecutively Conclusions of Law 1 to 13, inclusive, as submitted by the defendant and adopted by the Court.

Note that in denying defendant's motion (Joint App. 41) to amend Conclusions of Law by striking plaintiff's Conclusion of Law P-5. (Conclusion of Law 15 below), the Court entered the following order (Joint App. 43):

> "ORDERED that paragraph (1) of the defendant's Motion to Amend Conclusions of Law be and the same is hereby denied, it being the ruling of the Court that the Commissioner of Patents has original jurisdiction of interference proceedings such as Interference No. 83,266; that the United States District Court for the District of Columbia and the United States Court of Customs and Patent Appeals have alternate statutory review; and that the United States Court of Appeals for the District of Columbia Circuit and the United States Supreme Court have appellate jurisdiction; * * *."

FINDINGS OF FACT

1. This is an action brought under Title 35 of the United States Code, Section 145, in which plaintiff, Preformed Line Products Company, sought to have the Court authorize the allowance of claims 3, 6, 7, 10, 11, 15 through 20, 22, 24, 26, 27, 30, and 31 of Peterson patent application Serial No. 698,342 claims 4, 5, 8, 9, 14, 21, and 25 having

been allowed by the examiner and claims 12 13, and 23 having been held patentable by the Board of Appeals. Claims 6, 7, 10, 11, and 22 were eliminated from the case by the granting prior to trial of plaintiff's motion to dismiss as to those claims.

2. In this action plaintiff further sought to have the Court authorize the allowance of claims 1 through 11, 13 through 16, and 21 through 28 of Peterson patent application Serial No. 2,200, which claims are all the rejected or nonallowed claims remaining therein.

3. The application in suit discloses preformed helical elements and various species of tube-like structures produced from such preformed helical elements for use as envelopes for elongated bodies, cable splices, vibration dampeners, etc. Each application discloses also at least one specific method of assembling preformed helical elements as an envelope on a core.

4. Claims 16, 17, 18, 20, and 24 of application Serial No. 698,312 and Schedule A of the complaint are not readable on the species elected for prosecution in that application in the absence of an allowable generic claim and, therefore, are not before the court for judgment on the merits. Claims 3, 15, 19, 26, 27, 30, and 31 set forth in the same application and schedule are before the Court on the merits.

5. Claims 1 through 5, 7, 9 through 11, 13, 14, 15, 21, and 22 of application Serial No. 2,200 and Schedule B of the complaint are not readable on the species elected for prosecution in that application in the absence of an allowable generic claim and, therefore, are not before the Court for judgment on the merits. Claims 6, 8, 16, and 23 through 28 set forth in the same application and schedule are before the Court on the merits.

6. Claims 26, 27, and 31 of the earlier Peterson application are identical with claims 27, 28 and 16, respectively, of the later Peterson application.

7. The following findings 9 through 21 are pertinent to the issue of *res judicata* involved in claims 26, 27, and 31 of the earlier Peterson application and claims 27 and 28 of the later Peterson application.

8. All the facts of following findings 9 through 16, 19, 20, and 21 are pleaded in plaintiff's complaint and are admitted in defendant's answer.

9. After claims of the earlier Peterson application were rejected on Bodendieck patent No. 2,414,136, issued January 14, 1947, Peterson copied claims from said patent in that application for purposes of interference with said patent. After final rejection of the copied claims on the ground that the disclosure of the earlier application does not support them, an appeal was taken to the Board of Appeals (Appeal No. 15,663).

10. During the pendency of that appeal, Peterson filed the later of the applications involved in this action and designated it a continuation-in-part of the earlier application. The later application included original claims copied from the Bodendieck patent No. 2,414,136 which claims were identical with similarly copied claims in the earlier application.

11. Interference No. 83,256, Peterson v. Bodendieck, was subsequently declared between Peterson's later application and the said Bodendieck patent on the claims copied therefrom.

12. Subsequently, the Board of Appeals in above-mentioned Appeal No. 15,663 reversed the examiner to the

extent of holding that Peterson's earlier application would support certain claims copied from the Bodendieck patent.

13. Thereafter, Peterson moved to add his earlier application to Interference No. 83,266 in support of the issues thereof.

14. The examiner then dissolved the interference on the ground that the counts were not supported by either of Peterson's applications; but he was subsequently persuaded to permit the interference to proceed to final hearing for determination of the question of support for the claims.

15. In its decision on final hearing, the Board of Interference Examiners adopted the reasoning of the examiner in his decision dissolving the interference and held that Peterson could not make the claims derived from the Bodendieck patent in either of his applications. Priority of invention was awarded to Bodendieck.

16. Timely notice of appeal to the Court of Customs and Patent Appeals, in accordance with 35 U.S.C. 59a, R.S. 4911, then in effect, was given by applicant to the Commissioner of Patents from the above-mentioned decision of the Board of Interference Examiners, and no election was made by Bodendieck to have further proceedings conducted under 35 U.S.C. 63, R.S. 4915, then in effect.

17. Thereafter, but prior to expiration of the time available for perfecting the appeal to the Court of Customs and Patent Appeals, Bodendieck filed a statutory disclaimer (under 35 U.S.C. 65, R.S. 4917, then in effect) of his patent claims at issue in the interference proceedings and also Bodendieck's concession of priority of invention in the subject matter of the interference counts to Peterson.

18. Thereafter, in the Patent Office applicant seasonably moved to vacate the judgment of the Board of Interference Examiners in above-mentioned Interference No. 83,266, and further moved to dismiss the *inter partes* appeal to the Court of Customs and Patent Appeals; but his motions were denied by the Assistant Commissioner of Patents.

19. Subsequently, after Bodendieck filed a paper noting that Peterson had not perfected his appeal to the Court of Customs and Patent Appeals within the time allowed, the Assistant Commissioner ruled that, under Rule XXV of said Court, the interference proceedings were terminated and the Peterson applications were to be remanded to the primary examiner for further prosecution.

20. The examiner thereafter finally rejected the claims derived from the Bodendieck patent, as well as other claims held not to distinguish materially therefrom, in both the earlier and later Peterson applications on the basis of the decision of the Board of Interference Examiners at final hearing in Interference No. 83,266, holding that Peterson's applications do not support those claims.

21. On appeals from the final rejections, the Board of Appeals (Appeals No. 343-33 and No. 343-34) held that the rejection of the claims mentioned in finding of fact 20 and including all the claims mentioned in finding of fact 7 was essentially on the ground of *res judicata* and affirmed the examiner.

22. On the same appeals, the Board of Appeals did *not* hold that the doctrine of *res judicata* was applicable to the same claims on the basis of the decision of the Board of Appeals in Appeal No. 15,663, mentioned above in findings of fact 9 and 12.

24. The Moxham patent No. 337,513 of March 9, 1886,

discloses a wire cable formed of a plurality of preformed helical wires which are identical in shape with Peterson's preformed wires but of no definite length. The cable may be made with or without an internal core. If a core is used, the internal diameter of the preformed helical wire may be equal to or slightly less than that of the core. The resulting structure is elastic and compact. When the core is omitted, there is produced a tube of indefinite length composed of helices which are mutually coherent.

24. Claims 3, 15, 19, and 30 of the earlier application include neither an express nor implied limitation as to length. These claims distinguish from Moxham only in matters of degree expressed in terms of intended purpose, function, desired characteristic, or capability. These claims fail to distinguish structurally in matters of kind from Moxham. These claims do not define invention over Moxham.

25. Claims 6 and 8 of application Serial No. 2,200 which recite "a vibration dampener for suspended lines" distinguish from a length of the Moxham cable only in terms of intended use. The substance of the clause "adapted for connection with the line" is inherent in almost any free body and particularly in that of Moxham. The core of Moxham is a "filler substance" and occupies the central portion as well as other portions of the envelope tube. These claims define no invention over Moxham.

26. The publication entitled "P.F.T. Preformed Armor Rods and Multiple Wire Ties" bears a copyright date of 1946 and discloses a pair of wrenches and their use in applying preformed helical armor wires to energized power lines without interrupting service. Half of the rods are placed in the upper oblong slot and the other half into the lower slot of each tool. In position with respect to the

line, the jaws are closed and while one wrench is held stationary the other wrench is rotated and moved outwardly to effect the wrapping for one half the longitudinal extent of the armor. This latter wrench is then clenched over the armor and held stationary while the formerly stationary wrench is rotated around the line and moved outwardly toward the other end to complete the wrapping.

27. Claim 16 of application Serial No. 2,200 was held by the Board of Appeals to be adequately supported by the disclosure of that application. This claim is identical with claim 31 of application Serial No. 698,312; but since the decision of the Board of Interference Examiners, holding said claim 31 not supported by the disclosure of application Serial No. 698,312, is in this action found to establish *res judicata* as to that issue, claim 16 is supported only by the disclosure of application Serial No. 2,200, filed January 14, 1948, and is fully anticipated by the disclosure of the 1946 "P.F.T." publication which constitutes a statutory bar.

28. Claims 27 and 28 of application Serial No. 2,200 are identical with claims 26 and 27 of application Serial No. 698,312. Since the decision of the Board of Interference Examiners holding said claims 27 and 28 not supported by the earlier application is in this action found to establish *res judicata* on that issue, those claims have no effective filing date prior to January 14, 1948. Claim 27 is fully anticipated by the disclosure of the "P.F.T." publication of date 1946 which constitutes a statutory bar. Claim 28 differs from the "P.F.T." publication disclosure only in the limitation "outwardly toward both ends . . . . simultaneously." The substance of that limitation is such that the subject matter of this claim would have been obvious at the time the alleged invention was made to a person hav-

ing ordinary skill in the art. Claim 28 sets forth no invention over the "P.F.T." publication.

29. Claims 23 through 26 of application Serial No. 2,200, drawn to method, are inadequately supported by the application disclosure. Claims 23 and 24 are not supported by disclosure of either "simultaneously twisting the groups" or "mutually twisting said helical units." Claims 23 through 26 are not supported by disclosure of how the groups of elements are to be maintained in the relationship recited in these claims.

30. None of claims 3, 15, 19, 26, 27, 30, and 31 of amended Schedule A and claims 6, 8, 16, and 23 through 28 of Schedule B of the complaint distinguishes patentably over the Moxham patent.

31. None of claims 3, 15, 19, 26, 27, 30, and 31 of amended Schedule A and claims 6, 8, 16, and 23 through 28 of Schedule B of the complaint distinguishes patentably over the cited prior art.

32. Plaintiff has failed to prove clear error or lack of rational basis in the findings of fact in the decisions of the Board of Appeals in Appeals No. 343-33 and No. 343-34.

CONCLUSIONS OF LAW

1. The doctrine of *res judicata* is applicable to final decisions of Patent Office tribunals including the Board of Interference Examiners.

2. The decision of the Board of Appeals in Appeal No. 15,663 is not a final decision and, therefore, a holding of *res judicata* could not properly be based thereon.

3. In the absence of a perfected appeal after Peterson's notice of appeal to the Court of Customs and Patent Ap-

peals from the judgment of the Board of Interference Examiners awarding priority to Bodendieck in Interference No. 83,266, the unvacated judgment of that Board became a final judgment.

4. The Board of Appeals correctly held in Appeals No. 343-33 and 343-34 that the question of Peterson's right to make in his applications the respective claims listed in finding of fact No. 5 was *res judicata* on the basis of the decision of the Board of Interference Examiners at final hearing in Interference No. 83,266.

5. No patentable distinction is involved in mere matters of degree.

6. A claim is functional and unpatentable if it seeks to define the essential substance of an alleged invention in structure or apparatus merely by statements of intended purpose, result, desired characteristic or capability, or a mode of operation instead of by structure or by means for achieving the desired end.

7. Limitations not within the specific provisions of 35 U.S.C. 112 and involving merely introductory matter, statements of intended use, or "adapted" clauses, are patentably ineffective.

8. A patent may not be obtained if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

9. Plaintiff is not entitled to prevail in the absence of demonstration of clear error or lack of rational basis in the decisions of the Board of Appeals in Appeals No. 343-33 and No. 343-34.

10. Plaintiff is not entitled to a patent containing any of claims 3, 15, 19, 26, 27, 30, and 31 set forth in amended Schedule A of the complaint.

11. Plaintiff is not entitled to a patent on application Serial No. 698,312, containing any of claims 6, 7, 10, 11, and 22 of original Schedule A of the complaint, which claims were eliminated by granting of plaintiff's motion to dismiss and amend.

12. Plaintiff is not entitled to a patent containing any of claims 6, 8, 16, and 23 through 28 set forth in Schedule B of the complaint.

13. The complaint should be dismissed as to all the claims.

14. The Court has jurisdiction over the parties and over the subject matter in suit.

15. The Commissioner of Patents had original jurisdiction over the parties and over the applications and patent involved in Interference No. 83,266 at the time the party Bodendieck filed his disclaimer and concession of priority therein.

16. The authority of the Board of Appeals to review adverse decisions of Examiners upon applications for patents is contained in Title 35 U. S. Code, § 7, and an applicant's right to a review from adverse decisions of Examiners is contained in Title 35 U. C. Code, § 134.

17. An interference is a proceeding between two or more applications, or between one or more applications and a patent of different parties, all of which contain claims directed to the same invention.

18. The statutory disclaimer speaks from the date of the patent.

STATUTES AND RULES CITED

STATUTES

35 USC § 7:

The examiners-in-chief shall be persons of competent legal knowledge and scientific ability. The Commissioner, the assistant commissioners, and the examiners-in-chief shall constitute a Board of Appeals, which, on written appeal of the applicant, shall review adverse decisions of examiners upon applications for patents. Each appeal shall be heard by at least three members of the Board of Appeals, the members hearing such appeal to be designated by the Commissioner. The Board of Appeals has sole power to grant rehearings.

35 USC § 134:

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal. (R. S. 4909; 35 U. S. C., 1946 ed., 57.)

35 USC § 112 (Last paragraph):

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. (R. S. 4888; 35 U. S. C., 1946 ed., 33.)

35 USC § 135:

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any

pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

35 USC § 141:

Appeal to Court of Customs and Patent Appeals

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects

to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case. (R. S. 4911; 35 U. S. C., 1946 ed., 59a.)

35 USC § 142:

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints. (R. S. 4912; 35 U. S. C., 1946 ed., 60.)

35 USC § 146:

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law. (R. S. 4915; 35 U. S. C., 1946 ed., 63. Act Mar. 3, 1927, ch. 364, 44 Stat. 1394 and Oct. 31, 1951, ch. 655, sec. 53a, 65 Stat. 728; 35 U. S. C., 1946 ed. 72a.)

Sec. 4917 R. S. (Then 35 USC § 65; now 35 USC § 253):

Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment,

stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it. [See R. S. secs. 973, 4922.]

PATENT OFFICE RULES

Rule 258:

In determining priority of invention, the Board of Patent Interferences will consider only priority of invention on the evidence submitted. Questions of patentability of a claim generally will not be considered in the decision on priority; and neither will the patentability of a claim to an opponent be considered, unless the non-patentability of the claim to the opponent will necessarily result in the conclusion that the party raising the question is in fact the prior inventor on the evidence before the Office, or relates to matters which have been determined to be ancillary to priority and must be considered, but a party shall not be entitled to raise such non-patentability unless he has duly presented and prosecuted a motion under rule 232 for the dissolution upon such ground or shows good reason why such a motion was not presented and prosecuted.

Rule 262(a) and (d):

Disclaimer, concession, abandonment. (a) An applicant or a patentee involved in an interference may, at any time, file a written disclaimer or concession of priority, or abandonment of the invention, signed by the inventor in person

with the written consent of the assignee when there has been an assignment. Upon the filing of such an instrument by any party, judgment shall be rendered against him.

• • •

(d) Such disclaimer, concession of priority, abandonment of the invention, or abandonment of the contest shall operate without further action as a direction to cancel the claims involved from the application of the party making the same on termination of the interference on the basis thereof.

Rule 263:

Statutory disclaimer by patentee. The disclaimer referred to in rule 262, when made by a patentee in interference is not a disclaimer under 35 U. S. C. 253. If a disclaimer under the statute (see rule 321) cancelling claims involved in the interference from the patent, is made by the patentee, including all assignees as shown by the records of the Patent Office, the interference will be dissolved pro forma as to such claims.

COURT OF CUSTOMS & PATENT APPEALS

Rule XXV (1.):

PETITION OF APPEAL—TRANSCRIPT OF RECORD

1. In appeals from the Patent Office the appealing party shall file in the clerk's office a petition, addressed to the court, in which he shall briefly set forth and show that he has complied with the requirements of sections 4912 and 4913 of the Revised Statutes of the United States to entitle him to an appeal, and praying that his appeal may be heard upon and for the reasons assigned therefor to the Commissioner. Said reasons for appeal having been filed

with the Commissioner of Patents and made a part of the record, shall not be repeated in the petition of appeal. Said petition of appeal and a certified copy of the record in the proceeding shall be filed in this court and the case duly docketed within 40 days (exclusive of Sundays and legal holidays) from the date upon which said reasons for appeal were filed with the Commissioner of Patents: *Provided*, That the commissioner may for special and sufficient cause extend such time to some definite and fixed date: *Provided, further*, That in inter partes cases appellant shall, at the time of filing said petition of appeal in this court, or within 10 days thereafter, serve a copy thereof upon appellee or his counsel.

If said petition of appeal and copy of said record shall not be filed within said period of 40 days, unless such time be extended by the commissioner as heretofore provided, the commissioner, upon such facts being brought to his attention by motion of the appellee in inter partes cases, duly served upon the appellant or his attorney, and upon his own motion in ex parte appeals, may take such further proceedings in the case as may be necessary to dispose of the same as though no notice of appeal had ever been given. *Provided, however*, That if any adverse party in an interference case shall, within 20 days after appellant shall have filed notice of appeal to this court, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes, certified copies of the notice of appeal and the notice of election shall be transmitted to this court by the Commissioner of Patents for appropriate action according to law.

CHRONOLOGY

First Application filed	September 20, 1946
Second Application filed	January 14, 1948
Interference No. 83,266 (v. Bodendieck) declared	March 31, 1948
Judgment of Interference Board entered	May 23, 1950
Rehearing denied	July 31, 1950
Interference No. 83,266 appealed to the CCPA	August 25, 1950
Bodendieck Disclaimer filed	December 7, 1950
Motion to Vacate Interference Judgment denied	December 21, 1950
Limit to perfect appeal to CCPA	December 22, 1950
Decision of Board of Appeals, ex parte, both cases	April 30, 1954
Rehearing denied	June 28, 1954
Civil Action 3229-54 decided	March 13, 1957
Appeal No. 13,938 to this Court (103 US App. DC 286; 257 F. 2d 664) decided	June 26, 1958
Rehearing denied	September 4, 1958
Certiorari denied (79 SC 352; 358 US 945; 3 L. E. 2d 351)	January 26, 1959
Motion for new trial denied	April 15, 1959
Appeal No. 15,270 (280 F.2d 643) decided	June 9, 1960
This petition filed	October 7, 1960

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JAMES R. BROWNING, Clerk

No. 471

In the Supreme Court of the United States

OCTOBER TERM, 1960

[illegible]RMED LINE PRODUCTS COMPANY, PETITIONER

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

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In the Supreme Court of the United States

OCTOBER TERM, 1960

No. 471

PREFORMED LINE PRODUCTS COMPANY, PETITIONER

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The findings of fact, conclusions of law, and the oral opinion of the United States District Court for the District of Columbia (R. 26-35, 44-53)[1] are unreported. The opinion of the United States Court of Appeals for the District of Columbia Circuit (Pet. App. A-1 to A-4) is reported at 280 F. 2d 643. An earlier opinion in the same case is reported at 257 F. 2d 664, certiorari denied, 358 U.S. 945.

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[1] "R." refers to the Joint Appendix in the court below.

JURISDICTION

The judgment of the Court of Appeals was entered on June 9, 1960. On August 29, 1960, the time for the filing of the petition for a writ of certiorari was extended to October 7, 1960, by order of the Chief Justice. The petition was filed on October 7, 1960. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTIONS PRESENTED

1. Whether, in a proceeding in a United States District Court to order the Commissioner of Patents to issue a patent, the District Court has jurisdiction to deny the order on the ground that the claims lack the novelty essential to a patentable invention when the Patent Office had rejected the claims on a different ground.

2. Whether the District Court, as an alternative ground for denying relief, properly accepted a final judgment of the Board of Interference Examiners, from which an appeal had been noted to the Court of Customs and Patent Appeals but had not been prosecuted, as *res judicata* of a determination against the petitioner made therein.

STATUTE INVOLVED

35 U.S.C. 145 provides as follows:

> An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action

against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the appellant.

STATEMENT

The petitioner is the assignee of a patent application for a method and an apparatus for wrapping armor wire around another wire or cable for the purpose of reenforcing or splicing it, or forming terminals (R. 170-188). After multiple procedural steps,[2] the Board of Appeals in the Patent Office finally denied certain of the claims in the application on the ground that they were not supported by disclosures in the application (R. 298-340, 420, 430). In reaching this decision the Board held that, in certain aspects, it was bound by a prior decision of the Board of Interference Examiners, to which the application had previously been referred when the

[2] These proceedings are detailed in the Petition (pp. 1-7) and in the Government's Brief in Opposition when the case was before the Court on the prior appeal. See Brief in Opposition in No. 554, October Term, 1958.

applicant had claimed interference. After the Interference Examiners had decided adversely to this applicant, and he had noted an appeal to the Court of Customs and Patent Appeals, the competing inventor had entered a disclaimer and concession of priority. However, the Commissioner of Patents had ruled, on motion to vacate the appeal filed by the petitioner, that since an appeal had been noted he had no authority over the issue. The appeal was not prosecuted in the Court of Customs and Patent Appeals, and the determinations of the Interference Examiners became final and were accepted as *res judicata* in the further proceedings in the Patent Office.

Following the denial of the claims by the Patent Office, the petitioner instituted suit in the District Court under 35 U.S.C. 145 to compel the Commissioner of Patents to issue the patent on the rejected claims. The District Court denied the order, first, on the ground adopted by the Patent Office and, alternatively, on the ground that the claims lacked the novelty essential to patentability. On appeal, the Court of Appeals, without passing on the first ground, sent the case back in order to permit the petitioner to present its case on patentability. This Court denied a petition for certiorari on this order. *Preformed Line Products* v. *Watson*, 358 U.S. 945.

On remand, the District Court considered the proffer of evidence submitted by the petitioner to support its motion for a new trial and reaffirmed its holding that there was no showing of novelty. On appeal, the court below affirmed the order of the District Court.

ARGUMENT

1. The petitioner's chief complaint is that the District Court in a proceeding under 35 U.S.C. 145 reached its determination denying certain patent claims on a ground not followed by the Patent Office, namely, that the claims lacked novelty. The attack is not on the findings themselves, but on the authority of the court to consider the issue *sua sponte*. Both courts upheld the power of the courts to consider the issue, and both the language of the statute and its prior construction support them in that position.

The language of the statute, 35 U.S.C. 145, *supra*, pp. 2-3, seems clearly to contemplate not only that the court will decree whether the moving party has been aggrieved by the action of the Patent Office, but that its determination shall constitute a determination of whether the applicant is entitled to a patent. Thus, the statute provides:

> * * * The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law.

Since, under 35 U.S.C. 101, to justify a patent an invention must be a "new and useful" process or machine, it seems clear that a court may not order the Commissioner to issue a patent without considering this basic condition precedent.

In *Hill* v. *Wooster*, 132 U.S. 693, the Patent Office had determined a question of priority in an interference proceeding between two inventors. In the Circuit Court, where a suit in equity had been commenced to reexamine this decision, priority was determined in favor of the plaintiff. The Supreme Court, however, decided the dispute not on the basis of priority, but on the ground that the claims were not entitled to a patent. The Court stated at 698:

> The provision of section 4915 is that the Circuit Court may adjudge that the applicant "is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear;" and that, if the adjudication is in favor of the right of the applicant, it shall authorize the Commissioner to issue the patent. It necessarily follows that no adjudication can be made in favor of the applicant, unless the alleged invention for which a patent is sought is a patentable invention. * * *
>
> The parties to the present suit appear to have been willing to ignore the question as to patentability in the present case, and to have litigated merely the question of priority of invention, on the assumption that the invention was patentable. But neither the Circuit Court nor this court can overlook the question of patentability. * * *
>
> We are of opinion that nothing in those four claims constitutes a patentable invention. * * *

See also *Sanford* v. *Kepner*, 344 U.S. 13, 15.

The petitioner seeks to distinguish these cases on the ground that they involve competing claims by inventors, rather than a proceeding by a single inventor to contest a decision by the Commissioner (Pet. 20-25). However, the procedures in the two types of proceeding (35 U.S.C. 145 and 146) derive from the same source, R.S. 4915, and the authorization in the present Section 145 is explicit in requiring the court to make a finding on whether the applicant is "entitled to receive a patent." There is no foundation for the petitioner's distinction.

2. On the separate ground for decision, which was not passed upon by the court below, the District Court upheld the Board of Review in holding that the issue of whether the claims were properly supported by the declarations was *res judicata* by reason of the final decision on that issue by the Board of Interference Examiners. Although the petitioner had attempted to reopen that decision by a motion to the Commissioner to vacate the appeal from that decision to the Court of Customs and Patent Appeals, the Commissioner had denied that motion on the ground that he had no jurisdiction after the notice of appeal had been noted. That position is correct. *Galena Manufacturing Co.* v. *Superior Oil Works*, 26 C.C.P.A. (Patents) 1301, 104 F. 2d 400; *In re Allen*, 28 C.C.P.A. (Patents) 792, 799-800, 115 F. 2d 936, 941-942; *Myers* v. *Polk Miller Products Corp.*, 40 C.C.P.A. (Patents) 739, 742, 201 F. 2d 373, 375. Thereafter, when the appeal to the Court of Customs and Patent Appeals was neither prosecuted nor remanded by that court, the decision of the Board of Interference Examiners

became final (35 U.S.C. 135) and the issues decided therein became *res judicata* in all further proceedings in connection with the application.[3]

CONCLUSION

For the foregoing reasons, we respectfully submit that the petition for a writ of certiorari should be denied.

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NOVEMBER 1960.

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[3] The petitioner argues that a contrary decision at an earlier stage in the proceeding when the application was still being considered *ex parte* was *res judicata* on the *inter partes* proceeding before the Board of Interference Examiners (Pet. 27-28). The flaw in this argument is that *ex parte* decisions are not binding on subsequent *inter partes* proceedings. *Armstrong* v. *Levy*, 29 F. 2d 953 (C.A. D.C.); *Thompson* v. *Dicke*, 27 C.C.P.A. (Patents) 931, 935-936, 110 F. 2d 98, 101-102; *Durdin* v. *Nordell*, 38 C.C.P.A. (Patents) 1187, 1191, 190 F. 2d 211, 214.

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SUPREME COURT OF THE UNITED STATES

NO. 471

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

PETITIONER'S REPLY TO RESPONDENT'S OPPOSITION

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1960

NO. 471

PREFORMED LINE PRODUCTS COMPANY,
Petitioner

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS,
Respondent

Petition for Writ of Certiorari to the United States Court of Appeals for the District of Columbia Circuit

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PETITIONER'S REPLY TO RESPONDENT'S OPPOSITION

Respondent's Questions Presented Are Erroneous

Respondent asserts that only two questions are presented in the pending petition for certiorari (Res. Br. 2). Both of Respondent's questions presented are inaccurate and misleading, the first being derived from facts which lead to Petitioner's second question presented; Respondent's second question presented being derived from facts to which Petitioner's fifth and sixth questions presented are addressed (Pet. 2, 3).

RESPONDENT'S FIRST QUESTION

It is not important here that the claims involved in the interference between Petitioner's assignor, Peterson, and the patentee Bodendieck were ultimately denied Peterson on the grounds that his applications lacked basis in their disclosures to support them. This was merely an *ex parte* reiteration by the Examiner of the *inter partes* ruling in the case by the Interference Board.[1]

What is important here is that the claims in question had already been adjudged patentable by the Commissioner of Patents and had actually been patented to Bodendieck (Joint App. 508, 511, Claims 1 and 2). This was a proper exercise of the administrative function vested in the Commissioner of Patents by the Congress under the provisions of Article I, Section 8 of the Constitution. No issue was raised in the pleadings nor on the trial before the District Court concerning these claims. The Court, *sua sponte*, held that these claims were not directed to patentable subject matter, thus, in effect, supervening the Commissioner's judgment to the contrary.

The issue is, therefore, not whether the Court has jurisdiction to find novelty lacking in *rejected* claims, as asserted in Respondent's first question presented; rather, whether the Court has jurisdiction to adjudge as unpatentable *patented* claims whose novelty (or patentability *vel non*) was not in issue, as asserted in Petitioner's second question presented.

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1. The Board of Appeals in a precedential *ex parte* appeal had already decided that there was basis to support these claims in Peterson's first application. It is Petitioner's position, not that prior *ex parte* decisions are binding on subsequent *inter partes* proceedings, but are binding on subsequent *ex parte* proceedings that follow the *inter partes* action when nothing eventuated in the latter to change the precedential *ex parte* status. Compare this with the note in the margin of Respondent's brief, p. 8.

RESPONDENT'S SECOND QUESTION

Respondent's apprehension of the second question presented is wrong because it is predicated upon certain assumptions in prejudgment of the ultimate issues before the Court. In the first place, Respondent has assumed that the judgment of the Interference Board is a *final* judgment. Petitioner asserts that *it was not a final judgment.* The facts are recited in the full paragraph of page 6 of the petition.

The Interference Statute[2] provides for the determination of the question of priority of invention between applicants for patent or between an applicant and a patentee. There must be rival claimants.[3] Here, Peterson copied Claims 1 and 2 of Bodendieck's issued patent into his pending application, and made them a matter of original record in his second application. An interference evolved, between Peterson and Bodendieck who became rival claimants for this patented subject matter. The Interference Board denied basis in either Peterson application to support the patented claims.[4] From this judgment notice of appeal to the CCPA was given. At this juncture, before the record was forwarded to the Court, Bodendieck filed his disclaimer of the patented claims, also, conceded priority to Peterson. Respondent does not deny that the interference was pending in good standing when this action was taken.

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2. 35 USC §135, reproduced in Pet. App. A-15, A-16.

3. *Lattig & Goodrum* v. *Dean*, 25 App. D.C. 592; 1905 C.D. 698; *Oliver* v. *Felbel*, 20 App. D.C. 262; 1902 C.D. 565.

4. The Interference Board adopted the Examiner's view as to Peterson's lack of disclosure. Acting *inter partes*, the Examiner was not bound by the *ex parte* ruling of the Board of Appeals holding to the contrary.

The law controlling this situation is clearly recited in Patent Office Rules governing patent cases No. 262(a), 262(d), and 263[5], which have the effect of law.[6] It is provided that an applicant or *a patentee* involved in an interference may, *at any time*, file a written disclaimer or concession of priority, whereupon judgment shall be rendered against him; the claims will be automatically stricken, and the interference terminated on this basis. In cases of statutory disclaimer (as here), the interference will be dissolved pro forma as to such claims.

Petitioner seasonably moved the Commissioner to vacate the Interference Board's judgment under the mandate of Rules 262 and 263.[7] The motion was denied December 21, 1950, and the limit of appeal to the CCPA expired the next day. Contrary to Respondent's assertion, Petitioner urges that the interference terminated when the disclaimer was filed by the patentee, and not two weeks later when the limit of appeal to the CCPA expired. The law is clear that the Commissioner must vacate the judgment of the Interference Board, and that *it is mandatory rather than discretionary upon him to do so.* Therefore, contrary to Respondent's second question presented, the Interference Board's judgment was not a *final* judgment, is void in law, and cannot constitute the basis for *res judicata* in the *ex parte* prosecution that ensued.

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5. Petition, 26; Pet. App. A-19, A-20.

6. *Geophysical Development Corp.* v. *Coe*, 136 F.2d 275; 78 U.S. App. D.C. 39; cert. den. 320 U.S. 760. *Gearon et al.* v. *U. S.*, 121 F.S. 652; *Land* v. *Dreyer*, 155 F.2d 383.

7. The District Court found that the Commissioner of Patents had original jurisdiction in this case. Attention is invited to page 6, note 7 in the margin of the petition; Court Order p. A-5, and Conclusions of Law 15 at p. A-14.

Conclusion

The jurisdictional issues raised by this petition, recited in Petitioner's questions presented, are of first importance in the public interest as well as in the interest of Petitioner.

The Writ should issue.

Respectfully submitted,

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November 15, 1960